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PATENT

TECH CENTER 1600/0900
Application No. 09/717,204

Attorney Docket No. 5725.0642-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Sam B. Morrison

Application No.: 09/717,204

Filed: November 22, 2000

For: A TRANSFER RESISTANT
ANHYDROUS COSMETIC
COMPOSITION

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) Group Art Unit: 1617

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) Examiner: M. Willis

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Terminal Disclaimer

Assignee, L'Oréal S.A., duly organized under the laws of FRANCE and having its principal place of business at 14, Rue Royale, 75008, Paris, France, through its attorneys, represents that it is the assignee of the entire right, title and interest in and to the instant Application No. 09/717,204, filed November 22, 2000, in the name of Sam B. MORRISON, for A TRANSFER RESISTANT ANHYDROUS COSMETIC COMPOSITION, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011809, Frame 0021 on May 16, 2001. Assignee, L'Oréal S.A further represents that it is the assignee of the entire right, title and interest in and to the following U.S. patent application:

U.S. Application No. 09/258,809, filed February 26, 1999, in the names of Carolyn CAES, Gary GRAVES, Mohamed KANJI, Margarita MONTES DE OCA, Greg

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04/11/2003 YPOLITE 00000032 09717204

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NORMAN, Carol ORR, and Paul THAU, now issued as U.S. Patent No. 6,423,306, for COSMETIC COMPOSITIONS CONTAINING DI-BLOCK, TRI-BLOCK, MULTI-BLOCK AND RADIAL BLOCK COPOLYMERS, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 010045, Frame 0469 on June 22, 1999.

Evidentiary documents have been reviewed and, to the best of assignee's knowledge and belief, title to both the instant application and the U.S. patent application listed above is in the assignee submitting this Terminal Disclaimer.

To obviate a double patenting rejection, assignee hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173, as presently shortened by any terminal disclaimer, of any patent granted on patent Application No. 09/258,809, Assignee hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on patent Application No. 09/258,809 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, Assignee does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of any patent granted on patent Application No. 09/445,588, as presently shortened by any terminal disclaimer, in the event that any patent granted on patent Application No. 09/445,588 later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid

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by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required fee of \$110.00 is being filed with this disclaimer.

If a check for the required fee is not filed concurrently herewith or if there are any additional fees due in connection with the filing of this Terminal Disclaimer, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 06-0916.

The undersigned is an attorney of record.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Shelia V. Wannerment, Reg No 39,064
By: *for Anthony C. Tridico*

Anthony C. Tridico
Reg. No. 45,958

Dated: April 10, 2003

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SUBJECT: DECISION ON TERMINAL DISCLAIMERS - INFORMAL FORM

DATE: 4-18-03

APPL. S.N.: 091717,204

TO EXAMINER: M. Williams

ART UNIT: 1617

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 4-10-03

AFTER FINAL YES ☒ NO ☐ NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$ _____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity, (See 14.28).

☐ is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3)(For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$ _____. (See 14.35, 14.36).

☐ **EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP.**

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)